

Remarks

By this amendment, Applicant cancels claims 1–14 to more particularly set forth the present invention. Applicant previously submitted claims 15–21 in a preliminary amendment. The following claims remain in the application:

Independent claims: 15, 18, 21.

Dependent claims: 16, 17, 19, 20.

In preliminary matters, Applicant has cancelled claims 1–14. Therefore, Applicant respectfully submits that the informalities identified by Examiner in claims 1–14 are now moot. However, Applicant has amended claims 15 and 18 in accordance with Examiner's suggested changes to cancelled claims 1 and 14.

The present invention is a gaming machine and method for operating a secondary game that is separately displayed and separately triggered from a primary game. According to amended claims 15–21, the present invention is a gaming machine that includes a processor communicating with a primary game display, a mechanical secondary game display, and means for receiving a wager and prompting play. In response to the receipt of a wager, the processor conducts a primary game at the primary game display to produce a primary game outcome. Additionally, the processor selects, independent of the primary game outcome, between a secondary game trigger or no trigger condition. If the secondary game trigger condition is selected, the secondary game is conducted at the secondary display.

Examiner rejected claims 1–14 under 35 U.S.C. section 103(a) based on Slomiany in view of Bennett. Slomiany discloses a slot machine that awards a bonus game when certain bonus symbols are obtained in the primary slot machine game. See Slomiany, col. 5, l. 59–col. 6, l. 6. Upon obtaining a bonus outcome in the primary game, Slomiany awards a bonus game in

which a spinner selects from a set of selection elements. See *id.* at col. 7, ll. 12–29. The awards may take two different forms: the player may be awarded the value of the selection element or the player may be awarded based on the quantity of times a particular selection element is selected.

Bennett discloses a slot machine in which a second screen game is awarded based on the size of the player's wager for a primary game, see Bennett, col. 5, ll. 18, and the expected turnover of the primary game, see *id.* at col. 5, ll. 38–61. Once the second screen game is triggered, the player plays a series of sub-games that, if successfully completed, each result in an incremental prize.

Amended claim 15 is distinguishable from Slomiany alone or in combination with Bennett. Amended claim 15 recites a gaming apparatus with a mechanical secondary game display. As discussed in the application specification, the mechanical device is physically rotatable to display a selected secondary game award.

By contrast, neither Slomiany nor Bennett disclose a mechanical secondary game display. This is significant because the mechanical display allows the display of secondary game awards “prior to the selection of said secondary game trigger condition” as recited in claim 15.

Slomiany and Bennett do not show the secondary game awards prior to the selection of the secondary game trigger. Slomiany does not display the secondary game awards until after the bonus game is triggered. That is, as shown in FIG. 4 of Slomiany, the display (at reference number 24) normally shows a “Bank.” The secondary game awards “appear upon set up of the BIG BANG PIGGY BANKIN™ bonus game” as shown in FIG. 5. Thus, until the bonus game is actually triggered, the secondary game awards are not displayed in Slomiany.

Like Slomiany, Bennett does not show the awards for the second screen game prior to the triggering of the second screen game. First, Bennett only awards one prize for each “sub-game” and, thus, does not display a *plurality* of secondary game awards available. Second, Bennett does not display the incremental prize that can be won during a sub-game before triggering the sub-game. Rather, Bennett display the incremental prize available only after the player conducts and completes each “sub-game.” While the total prize pool is displayed and decremented after a player wins a sub-game, this does not anticipate Applicant’s display of a *plurality* of secondary game awards *available* because: (a) the total prize pool is only one prize, not a *plurality* of prizes, and (2) the total prize pool displayed is not *available* during a sub-game, only a portion of that prize pool (referred to as an incremental prize) is available during play of a sub-game.

Nor is the element of displaying a plurality of secondary game awards rendered obvious by the cited art. As Examiner is no doubt aware, a prior art reference (or references when combined) must teach or suggest all the claimed limitations, M.P.E.P. section 2143, and obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention when there is some teaching, suggestion or motivation to do so found *either in the references themselves or in the knowledge generally available to those skilled in the art*. See In re Fine, 5 USPQ2d 1596 (Fed. Cir. 1988), M.P.E.P. section 2143.01.

In this case, neither Bennett nor Slomiany discloses the display of a plurality of secondary awards available to a player for a secondary game, before the secondary game is triggered. Rather, both cited references specifically display the award for the secondary game after the secondary game is triggered and, in the case of Bennett, won. In fact, one could construe Slomiany and Bennett as teaching away from displaying the secondary game awards available before the secondary game is triggered. Slomiany uses the display where the secondary

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game is conducted to display a “Bank” prize that can be won in the primary game. See Slomiany, col. 5, l. 66–col. 6, l. 3. As Examiner can appreciate, these displays are mutually exclusive. During the primary game, the “Bank” prize is displayed, during the bonus game, the bonus game is displayed. Therefore, Slomiany teaches away from displaying the bonus prizes before triggering the bonus game because the display is used in the primary game.

Similarly, Bennett teaches away from displaying the incremental prize available prior to the initiation of the second screen game because the amount of the incremental prize is simply not known until the second screen game is triggered. That is, the incremental prize of Bennett is a fraction of the total prize pool available, but since the total prize pool changes as players play the machines (see Bennett, col. 4, ll. 64–67) the incremental prize available to the player cannot be displayed until the second screen game is triggered and the incremental prize can be calculated.

In short, Slomiany, alone or in combination with Bennett, does not anticipate or render claim 15 obvious because neither cited reference shows the display of a plurality of secondary game awards on a mechanical display prior to the triggering of the secondary game. Rather, Slomiany and Bennett only show the display of bonus prizes after a bonus game is triggered.

Amended claim 15 also distinguishes over the prior art because the secondary game trigger condition of the claimed game is randomly selected. As Examiner agrees, Slomiany fails to show the random selection of a secondary game trigger condition. However, Applicant respectfully submits that Bennett also fails to disclose or suggest the random selection of a secondary game trigger condition. As Examiner is aware, “random” selection means that the selection is not predictable. However, Bennett specifically states that the bonus game is “preferably triggered randomly as a *function* of turnover” Bennett, col. 3, ll. 50–51. Bennett

also states that the “second screen game is activated when a machine has reached a predetermined dollar turnover” and, as an example, states that “whenever \$0 to \$300 has been turned over, the second screen appears.” *Id.* at col. 7, ll. 27–33. As Examiner can appreciate, Bennett is not truly random, but is predictable. That is, Bennett’s statement that the “second screen game is activated when a machine has reached a predetermined dollar turnover” clearly states that whether a future trial will trigger the second screen can be predicted based on the predetermined dollar turnover number.

By contrast, amended claim 15 recites that the processor is configured to “randomly select” between a secondary game trigger or no trigger condition. This is not based on any precondition or predetermined quantity as is disclosed in Bennett. Therefore Bennett fails to show the random selection recited in claim 15.

Moreover, Bennett fails to suggest the random selection of claim 15. Bennett states that the second screen feature may be triggered based on the turnover or “other more traditional trigger mechanisms could be employed.” *Id.* at col. 3, ll. 51–52. While Bennett discloses other non-random triggers (such as the quantity of games played) but never discusses using a truly random occurrence that cannot be predicted and is not dependent upon game play. As discussed above, Slomiany is solely directed to triggering a bonus game based on the primary game outcome. In short, neither reference provides a motivation to “randomly select” a trigger condition and, consequently, amended claim 15 is allowable over the cited art.

Claim 16 depends from claim 15 and is directed to a secondary display in the form of a mechanical wheel displaying secondary game awards and rotatable to select a displayed secondary game award. Neither Bennett nor Slomiany disclose or suggest such a secondary display. Bennett only shows a secondary slot machine game and Slomiany only discloses a

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spinner game. Neither shows a mechanical wheel. For this reason, and because claim 16 depends from allowable claim 15, Applicant respectfully submits that claim 16 is allowable.

Claim 17 depends from claim 16 and recites a segmented mechanical wheel in which each segment displays a secondary award. For the reasons advanced with respect to claim 16, and because claim 17 depends from allowable claim 16, Applicant respectfully submits that claim 17 is allowable.

Independent claim 18 is similar to claim 15, with claim 18 including an indicator to indicate the selection of a secondary award. Claim 18 is allowable for the same reasons advanced above with respect to claim 15. Specifically, the cited references fail to disclose or suggest a secondary display that displays the secondary awards available prior to the selection of a trigger condition. That is, the cited references show a secondary display that displays the secondary awards only after a secondary game has been triggered and, in the case of Bennett, won. Also, the cited references fail to disclose or suggest the random selection of a trigger-no trigger condition. Rather, Slomiany shows triggering based on the primary game outcome and Bennett shows triggering when a "machine has reached a predetermined dollar turnover." See Bennett, col. 7, ll. 27-28.

Claim 19 depends from claim 18 and is similar to claim 16. For the reasons advanced above with respect to claim 16, and because claim 19 depends from allowable claim 18, Applicant respectfully submits that claim 19 is allowable.

Claim 20 depends from claim 19 and is similar to claim 17. For the reasons advanced above with respect to claim 17, and because claim 20 depends from allowable claim 19, Applicant respectfully submits that claim 20 is allowable.

Amended claim 21 is similar to claims 15 and 18. Thus, Applicant submits that claim 21 is allowable for the reasons advanced above with respect to claims 15 and 18. Additionally, claim 21 is distinguishable from Bennett and Slomiany because the triggering of the secondary game recited in claim 21 is independent of the primary game outcome and the quantity of the wager. This is clearly distinguishable from the cited art.

Slomiany clearly does not show or suggest these features because Slomiany, as acknowledged by Examiner, fails to show or suggest triggering independent of primary game outcome. Thus, Slomiany cannot provide a motivation to provide the claimed triggering that is random, independent of primary game outcome, and independent of wager quantity.

As discussed above, the triggering of Bennett's second screen depends upon the quantity of the wager because it is "a function of turnover," i.e. the amount the machine has been played. Bennett, col. 3, l. 50. As the predetermined dollar turnover is reached at a machine, "the second screen appears." Bennett, col. 7, ll. 27-33. Thus, the triggering of Bennett is clearly dependent upon wager quantity and, thus, fails to show or suggest triggering that is dependent upon wager quantity.

Additionally, Bennett shows a game in which "the player's probability of being awarded a second screen game is proportional to the bet." See *id.* at col. 5, ll. 17-18. This occurs because each credit bet by the player "buys" an additional chance to trigger the second screen. This is clearly distinguishable from Applicant's game. To reiterate, Applicant's secondary game award of claim 21 is triggered randomly, independent of primary game outcome, and independent of wager quantity. Bennett clearly states that the likelihood of triggering the second screen game is dependent upon wager quantity, not independent of wager quantity. Therefore, Bennett fails to anticipate Applicant's game.

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Bennett also fails to suggest Applicant's game. Bennett's second screen trigger is integrally tied to wager quantity both in that the second screen is "activated when a machine has reached a predetermined dollar turnover" and in that the "player's probability of being awarded a second screen game is proportional to the bet." Bennett never states how the second screen trigger can be separated or freed from these constraints for triggering. Therefore, Bennett fails to suggest any randomly selected secondary game trigger that is independent of primary game outcome and wager quantity. Consequently, Applicant respectfully submits that claim 21 is allowable over the cited references.

Conclusion

Applicant submits that the claims as presented are now in condition for allowance. Should Examiner believe that a telephone interview would advance the prosecution of this application, the undersigned would invite and request such an interview.

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Respectfully submitted,
ANDERSON & MORISHITA

By: Robert Ryan Morishita

Robert Ryan Morishita
Registration No. 42,907
2725 S. Jones Blvd., Suite 102
Las Vegas, NV 89146
Telephone: (702) 222-2113